



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/019,262	03/14/2002	Mie Takahashi	2001-1890A	1310
513	7500	06/01/2004	EXAMINER	
WENDEROTH, LIND & PONACK, L.L.P. 2033 K STREET N. W. SUITE 800 WASHINGTON, DC 20006-1021			THERKORN, ERNEST G	
			ART UNIT	PAPER NUMBER
			1723	

DATE MAILED: 06/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/019,262

Examiner

Ernest G. Therkorn

Applicant(s)

TAKAHASHI ET AL.

Art Unit

1723

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 May 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 1723

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 18-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over that which is conceded to be old on pages 1-4 of the specification in view of each of Nakaya (Japan Patent No. 11-044689), Mochizuki (Japan Patent No. 10-332,700), and Takahashi (Japan Patent No. 11-094,817). At best, the claims differ from that which is conceded to be old on pages 1-4 of the specification in reciting use of a liquid impermeable sheet and two regions that the liquid impermeable sheet material does not cover. Nakaya (Japan Patent No. 11-044689) (Abstract) discloses a laminate protects the chromatographic strip. Nakaya (Japan Patent No. 11-044689) (Abstract) discloses spaces 9 in the coloring region, in addition to the sample addition region, enhance detection accuracy. Mochizuki (Japan Patent No. 10-332,700) (Abstract) discloses a moisture impermeable film allows the chromatographic test strip to be carried, handled, kept, and preserved after reaction. Mochizuki (Japan Patent No. 10-332,700) (Abstract)

discloses use of a hole in addition to the sample addition region for venting air.

Takahashi (Japan Patent No. 11-094,817) (Abstract) discloses that a moistureproof sheet allows the test strip to be preserved for a long time. Takahashi (Japan Patent No. 11-094,817) (Abstract) discloses tearing off portions of the moisture proof sheet for sample addition and as a confirmation window. It would have been obvious to use a liquid impermeable sheet either because Nakaya (Japan Patent No. 11-044689) (Abstract) discloses a laminate protects the chromatographic strip, or because Mochizuki (Japan Patent No. 10-332,700) (Abstract) discloses a moisture impermeable film allows the chromatographic test strip to be carried, handled, kept, and preserved after reaction, or because Takahashi (Japan Patent No. 11-094,817) (Abstract) discloses that a moistureproof sheet allows the test strip to be preserved for a long time. It would have been obvious to use a second region in which is conceded to be old on pages 1-4 of the specification either because Nakaya (Japan Patent No. 11-044689) (Abstract) discloses spaces 9 in the coloring region, in addition to the sample addition region, enhance detection accuracy; or because Mochizuki (Japan Patent No. 10-332,700) (Abstract) discloses use of a hole in addition to the sample addition region for venting air; or because Takahashi (Japan Patent No. 11-094,817) (Abstract) discloses tearing off portions of the moisture proof sheet for sample addition and as a confirmation window.

Claims 18-35 are rejected under 35 U.S.C. 102(B) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over each of Nakaya (Japan Patent No. 11-044689), Mochizuki (Japan Patent No. 10-332,700), and Takahashi (Japan Patent

No. 11-094,817). The claims are considered read on each of Nakaya (Japan Patent No. 11-044689), Mochizuki (Japan Patent No. 10-332,700), and Takahashi (Japan Patent No. 11-094,817). However, if a difference exists between the claims and each of Nakaya (Japan Patent No. 11-044689), Mochizuki (Japan Patent No. 10-332,700), and Takahashi (Japan Patent No. 11-094,817), it would reside in optimizing the elements of each of Nakaya (Japan Patent No. 11-044689), Mochizuki (Japan Patent No. 10-332,700), and Takahashi (Japan Patent No. 11-094,817). It would have been obvious to optimize the elements of each of Nakaya (Japan Patent No. 11-044689), Mochizuki (Japan Patent No. 10-332,700), and Takahashi (Japan Patent No. 11-094,817) to enhance separation.

The remarks urge that the disclosure on pages 1-4 of the specification is not conceded to be old, referring to MPEP 2129 and Jepson format claims. Since Jepson format claims are not present in the instant case, their discussion is not pertinent. However, labeling the section "Background Art" and extensive use of the words "conventional" and "conventionally" is sufficient to concede the subject matter to be prior art.

The remarks urge that the claim states that "other than the top surfaces of the upstream end and the downstream end, there is no uncovered part of the chromatography specimen of the present invention. However, the open-ended format of the claims does not preclude additional uncovered parts.

The remarks urge each of Nakaya (Japan Patent No. 11-044689), Mochizuki (Japan Patent No. 10-332,700), and Takahashi (Japan Patent No. 11-094,817) does not

disclose two end regions that the liquid impermeable sheet material does not cover. However, Nakaya (Japan Patent No. 11-044689) (Abstract) discloses spaces 9 in the coloring region, in addition to the sample addition region, enhance detection accuracy. The sample addition region of Nakaya (Japan Patent No. 11-044689) appears to be at one end and space 9 appears to be at the second end. Mochizuki (Japan Patent No. 10-332,700) (Abstract) discloses use of a hole in addition to the sample addition region for venting air. The sample addition region 8 of Mochizuki (Japan Patent No. 10-332,700) is clearly at one end and air vent opening 9 is at the other end. Takahashi (Japan Patent No. 11-094,817) (Abstract) discloses tearing off portions of the moisture proof sheet for sample addition and as a confirmation window. The sample addition window 7 is clearly at one end and confirmation window 9 is at the other end. As such, two regions that the liquid impermeable sheet material does not cover are considered to be disclosed by each of Nakaya (Japan Patent No. 11-044689), Mochizuki (Japan Patent No. 10-332,700), and Takahashi (Japan Patent No. 11-094,817).

The remarks urge patentability based upon the omission of a water absorption part. However, the open format of the claims does not preclude the use of a water absorption part.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

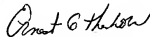
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

Art Unit: 1723

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to E. Therkorn at telephone number (571) 272-1149. The official fax number is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ernest G. Therkorn
Primary Examiner
Art Unit 1723

EGT
May 27, 2004